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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re amendment to the RICK K. SOUTHERN patent application

Serial No. 10/034,446

Examiner: Dennis Dorsey

Filed: December 26, 2001

Art Unit: 3637

For: METHODS FOR ATTACHING SOLID HARDWOOD FLOOR
PLANKS TO CONCRETE FLOOR SURFACES

Office Action mailed: July 2, 2003

Assistant Commissioner of Patents
Box 1450
Alexandria, VA 22313-1450

DECLARATION OF RICHARD HIRSCH UNDER 37 C.F.R. §1.132

I, Richard Hirsch, declare that:

1. I am the chief executive officer of the assignee of the above-identified application. I have been a professional in the flooring business for over the past 42 years. The assignee of the above-identified application, Richard-Marshall Fine Flooring, Inc., has developed expertise in the design, production and installation of solid wood floorboards.
2. I have read the PTO Office Action in the above-identified application mailed July 2, 2003, and have read each of the two cited U.S. patents, namely, Cohn U.S.P. 2,860,385 ("Cohn") and Sweet U.S.P. 5,830,549 ("Sweet"). Respectfully, I disagree with the PTO's assertions about the disclosures in these patents.

Hirsch Declaration
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3. Cohn does not refer to solid floorboards, but rather to strips of a sawdust/resin composition; see column 1, lines 55-57. Cohn makes the offhand assertion that it is possible to make strips of wood by proper woodworking machinery, but does not state that this product would be solid wood floorboards, let alone solid wood floorboards having a length of at least about 3 feet.
4. Cohn does not teach or suggest the use of the claimed water resistant/water impermeable adhesives of our claims. Instead, Cohn refers to "a conventional layer of mastic bonding material". Cohn states offhandedly that other adhesives and bonding agents can be used, but does not state what they might be, or what properties they must have. The water resistant/water impermeable adhesives that our claims call for did not even exist in 1956 when Cohn applied for the '385 patent, so Cohn was not referring to our claimed adhesives.
5. Cohn does not disclose or suggest nailing solid wood floorboards, having a length of at least about 3 feet, to a concrete floor surface with the nails passing through the floorboards, the adhesive and the concrete at right angles to the floorboards, as we claim. See Exhibit A hereto for a drawing illustrating what we claim. On the contrary, Cohn teaches that the conventional mastic adhesive that he uses, in combination with the diagonal slots formed in the bottom surface of his strips, alone hold Cohn's strips to concrete. Cohn therefore teaches away from nailing at all.
6. We have attempted to locate Mr. Cohn or others associated with him. We can find no record of Mr. Cohn, or of any company that produced his products at any time. His patent was assigned to a company called

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Reeder International based in San Francisco, California, according to a recorded assignment document. Reeder International does not exist, and according to the California Secretary of State, was never formed as a corporation, notwithstanding the assertion that it was a corporation in the recorded assignment document. Since Cohn proposes unworkable products that are wholly unlike what we claim, the absence of his products from the marketplace is unsurprising.

7. In an earlier filed amendment, we submitted a copy of the Hardwood Flooring Manual of the National Hardwood Flooring Association. See Exhibit B hereto. This manual, in its current edition, states that plank flooring must have an approved subfloor over the concrete product, and asserts that plank cannot be shot to concrete. If Cohn's products had succeeded, the manual should so indicate, reinforcing the unworkable nature of Cohn's products. Our claimed products adhere to concrete surfaces, as attested by the October 6, 2003 letter to me, attached hereto as Exhibit C.
8. I have also read Sweet. Sweet refers to a flooring product for application to a subfloor that comprises a wooden flooring component for installation with like flooring components. The flooring component must have a layer of adhesive applied and permanently adhered directly to the bottom surface of the wood-flooring component. A protective release cover is releasably adhered to the attachment interface surface of the adhesive to protect the adhesive until removal of the release cover when the flooring is applied to the subfloor. Our claimed product does not have, and cannot have, our claimed adhesives on the back surface of the solid wood planks.

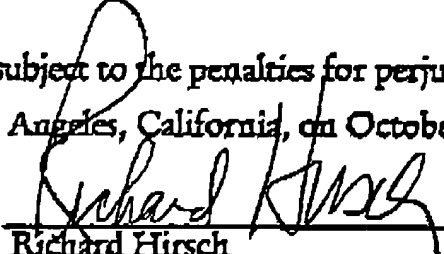
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9. Our claimed products do not use or have a hot melt adhesive, or any adhesive, applied to the back of the wood or a release cover, as in Sweet. If the adhesives we claim were applied directly to the back of the solid wood floor planks we claim, it would not be feasible to attach wood planks to concrete flooring.
10. Sweet does not disclose nailing his flooring product to a concrete floor through the floorboards and through water resistant/water impermeable adhesive, let alone at right angles to the floor, as we claim. On the contrary, the only disclosure of nailing in Sweet is to nailing other flooring products to a wood subfloor, not to concrete.
11. Sweet asserts that his flooring product can be installed over concrete "subfloor". He does not say what he means by a concrete subfloor. He does not refer to a concrete floor surface from which moisture can exude over time, as we claim. Nor does Sweet refer to water resistant/water impermeable adhesives, but instead solely to hot melt adhesives.
12. In my experience, the reason no one, including Sweet, has referred to nailing solid wood floor boards to concrete floor surfaces, is because, before our invention, no one could drive nails, at right angles to the wood floor, through solid wood floor boards and adhesive, and into a concrete floor surface below. In the past, attempts to drive nails into concrete floor surfaces led to chipping, and cracking of the concrete floor surface, in part because no one could drive nails at right angles as we claim. These failures do not occur with the products and methods we claim.

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I hereby declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful and false statements may jeopardize the validity of the application or any registration issued thereon, or any patent to which this verified statement is directed.

This declaration was executed subject to the penalties for perjury under the laws of the State of California, at Los Angeles, California, on October 29, 2003.


Richard Hirsch